

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl No.:	10/528321
Appellant:	Stephen Guffanti
Filing Date:	September 26, 2005
Art Unit/Conf. No:	3715/6770
Examiner:	Bruck A. Gebremichael
Attorney Docket No.:	100842.0002US
Title	Initial Teaching Alphabet for Teaching Phonetics

MS Appeal Brief - Patents
Commissioner of Patents and Trademarks
Washington, D.C. 20231
Attention: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF UNDER 37 CFR § 41.37

This brief follows the Appellant's Notice of Appeal filed in this matter on March 1, 2010.

The fees required under § 41.20, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains the following items under the headings in the order here indicated:

- I. Real Party In Interest
- II. Related Appeals And Interferences
- III. Status Of Claims
- IV. Status Of Amendments
- V. Summary Of Claimed Subject Matter
- VI. Grounds of Rejection To Be Reviewed On Appeal
- VII. Argument
- VIII. Claims Appendix
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I. Real Party In Interest

The real party in interest is the Appellant, Stephen Guffanti.

II. Related Appeals And Interferences

There are no other appeals or interferences in this matter known to Appellant.

III. Status Of Claims

1. Claims cancelled: 1-14;
2. Claims pending: 15-20;
3. Claims rejected: 15-20; and
4. Claims on appeal: 15-20.

IV. Status Of Amendments

Claims 1-20 were rejected in a Final Office Action mailed on October 28, 2009. Subsequent to the Final Office Action, Appellant filed an amendment on December 22, 2009. The amendment was considered by the examiner and was denied entry in an advisory action mailed on February 4, 2010. Section VIII recites the current status of the claims and is based on the amendment filed on December 22, 2009, which was denied entry by the examiner.

V. Summary Of Claimed Subject Matter

A) **Independent Claim 15** recites a method of teaching phonetic reading (See Abstract), comprising:

- a) presenting to a student an alphabet of phonetic symbols consisting of underlined and non-underlined letters selected from the group consisting of a, b, c, d, e, f, g, h, i, j, k, l, m, n, o, p, q, r, s, t, u, v, w, x, y, z; (See Specification P3/L14-20 and P6/L2-11 and corresponding Figure 6)

- b) presenting to the student a word with an ordinary spelling; and (See Specification P9/L22-29)
- c) revising at least part of the word to include at least one of the phonetic symbols. (See Specification/ P9/L27-29)

VI. Grounds of Rejection To Be Reviewed On Appeal

1. Rejection of claims 15-20 under 35 U.S.C. § 101 as being directed to a non-statutory subject matter. (Final Office action, page 3).
2. Rejection of claims 15-20 under 35 U.S.C. § 102(b) as being unpatentable over “Rocket Phonics.” (Final Office action, page 4).

VII. Argument

BACKGROUND

On **September 26, 2005** the Appellant filed application no. 10/528321 for Methods and Devices for Teaching Reading, claiming priority to PCT/US03/30790 filed September 15, 2003 and to application no. 60/411270 filed September 16, 2002.

On **May 25, 2006**, application no. 10/258321 was published as US-2006-0110713-A1.

On **September 19, 2008** the Office issued an office action and rejected claims 1-20. Claims 15-18 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 2-6, 13-14, and 18 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter of the invention. Claims 1-2, 7-13, 15 and 18-20 were rejected under 35 U.S.C. §102(e) as being unpatentable over US6604947 to Rai. Claims 3-4 were rejected under 35 U.S.C. §103(a) as being obvious over Rai. Claims 5 and 6 were rejected under 35 U.S.C. §103(a) as being obvious over Rai in view of US5214745 Sutherland. Claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over Rai in view of US4196529 to Esbensen. Claims 16 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rai in view of US6468084 to MacMillan.

On **October 14, 2008**, Appellant filed a response to the Office action dated September 19, 2008. Regarding the 35 U.S.C §101 rejections, the Appellant amended the claim to recite a method of teaching phonetic reading. Regarding the rejections under §112, second paragraph, Appellant agreed that the claims were indefinite and amended the claims to provide sufficient antecedent basis. Regarding the rejection under 35 U.S.C §102(e), Appellant amended the independent claims to clarify that the claimed method includes the step of "presenting to a student an alphabet of phonetic symbols consisting of underlined and non-underlined letters selected from the group consisting of a, b, c, d, e, f, g, h, i, j, k, l, m, n, o, p, q, r, s, t, u, v, w, x, y, z." Appellant pointed out that Rai taught using symbols consisting of both letters and symbolic icons drawn above or below the letters, whereas the Appellant's invention did not use symbolic icons above or below the letters. Regarding the 35 U.S.C. §103 rejections, Appellant disagreed and presented arguments as to it would not have been obvious to a person having ordinary skill in the art to combine.

On **January 14, 2009**, the Office issued a non-final office action and rejected claims 1-20. Claims 1-20 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Specifically, Claim 1 was rejected for not positively reciting any feature with structural limitations and claim 15 was rejected for not either (i) transforming the underlying subject matter to a different state or thing, or (ii) being tied to another statutory class. Claim 3 was rejected under 35 U.S.C §112, second paragraph, as being indefinite. Claims 1-13 and 15-20 were rejected under 35 U.S.C. §102(f) claiming that the subject matter of the invention was invented by both Stephen Guffanti and Maureen Guffanti, and was therefore not invented by only Stephen Guffanti as is listen in the prosecution history. Claims 1-13 and 15-20 were rejected under 35 U.S.C. §102(a) as being unpatentable over the book "Rocket Phonics." Claim 14 was also rejected under 35 U.S.C. §103(a) as being obvious over "Rocket Phonics" in view of US4196529 to Esbenesen.

On **April 9, 2009**, Appellant filed a response to the Office action dated January 14, 2009. Regarding the rejection of claims 15-20 under 35 U.S.C. §101, Appellant amended claim 15 to recite "revising at least part of the word to include at least one of the phonetic symbols." Regarding the rejections under 35 U.S.C. §102(f), Appellant submitted affidavits under 37 C.F.R. §1.131 from Maureen Guffanti that clarified that Maureen Guffanti merely helped write

the content of the book and did not actually invent the teaching method or materials. Regarding the rejection of claims 15-20 under 35 U.S.C. §102(a) in view of "Rocket Phonics," Appellant filed an affidavit under 37 C.F.R. §1.131 which clarified that Stephen Guffanti was in possession of, and reduced to practice, the claimed subject matter as early as February 2000, which was before the publication of "Rocket Phonics."

On **June 26, 2009**, the Office mailed a request for information under 37 C.F.R. §1.105 to provide any relevant publication, including the book "Rocket Phonics," prior to 9/12/2002, and argued that the book "Rocket Phonics" was published on August 15, 2001.

On **June 15, 2009**, Appellant's attorney, Andrew Mar, spoke to Examiner Gebremichael, explaining that the book "Rocket Phonics" was not actually published until October 2002, but that we would provide a copy of the book "Rocket Phonics" if the Office so wished to examine the book.

On **July 17, 2009**, Appellant mailed a response to the request for information and provided a copy of the book "Rocket Phonics."

On **October 28, 2009**, the Office issued a final Office action, rejecting claims 1-20. Claims 1-20 were again rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. Specifically, the Office argued claims 1-14 had no functional relationship between the printed matter and the substrate, and that claims 15-20 did not transform underlying subject matter to a different state, nor did were they tied to another statutory class. Claim 3 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1-13 and 15-20 were rejected under 35 U.S.C. §102(b) as being unpatentable over "Rocket Phonics." Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over "Rocket Phonics" in view of US4196529 to Esbensen.

On **December 22, 2009**, the Appellant filed a response to the final Office action dated October 28, 2009. Regarding the rejection of claims 1-14 under 35 U.S.C §101, Appellant disagreed with the Office but cancelled claims 1-14 to further prosecute the application. Regarding the rejection of claims 15-20 under 35 U.S.C. §101, Appellant disagreed but further amended claim 15 to recite that the word with ordinary spelling is presented on a "training material." Regarding the

rejection of claim 3 under 35 U.S.C §112, second paragraph, Appellant disagreed with the Office but cancelled claim 3 to further prosecution of the application. Regarding the rejection of claims 1-13 and 15-20 under 35 U.S.C §102(b), Appellant disagreed that "Rocket Phonics" is applicable prior art since it was actually first published on August 8, 2002 and the current application claims priority to a provisional application that was filed on September 16, 2002. Appellant further pointed out that the records at the United States Copyright Office were incorrect regarding the publication date of "Rocket Phonics" and submitted a declaration under 37 C.F.R. §1.131 to clarify the publication date.

On **February 4, 2010**, the Office issued an advisory action denying entry of Appellant's amendments filed on December 22, 2009 on grounds that the amendments raised new issues.

On **March 1, 2010**, Appellant filed a notice of an appeal.

ARGUMENT

A. Rejection Of Claims 15-20 Under 35 U.S.C. § 101(A) As Directed To Non-Statutory Subject Matter

The Office rejected claims 15-20 under 35 U.S.C. §101 for failing to transform underlying subject matter or satisfy the "machine-or-transformation test" as laid out in *In re Bilski* (Fed. Cir., 2007-1130, 10/30/2008). The Applicant respectfully disagrees.

1. Claims 15-20 Satisfy the Machine-Or-Transformation Test

The Federal Circuit held that a process or method claim qualifies as patentable subject matter if the claimed process or method either (1) is tied to a particular machine or apparatus or (2) transforms a particular article into a different state or thing. *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008) Transformation of an article must be central to the purpose of the claimed process. *Id.* at 962. The Federal Circuit has also stated that an "article" is a physical object or substance, or a representation of a physical object or substance. *In re Ferguson*, 558 F.3d 1359, 1364 (Fed. Cir. 2009). In cases where the article is a representation of a physical object, the underlying physical object need not be undergo a physical transformation in order for the process claim to qualify as patentable subject matter. *In re Bilski* at 963.

Here, Claim 15 recites "presenting training material to the student, wherein the training material has a word with ordinary spelling" and "revising at least part of the word to include at least one of the phonetic symbols." Any training material that has a word on it must be a physical object that a student can see and manipulate. This training material is then transformed by the addition of phonetic symbols to the word that is written on the training material. The training material necessarily needs to undergo a physical transformation for the words written on the material to be revised by the student.

2. Claims 15-20 Recite a Physical Process Controlled By A User

The Supreme Court held that "[t]he machine-or-transformation test is not the sole test for deciding whether an invention is a patent-eligible 'process'" *Bilski et al. v. Kappos* 561 U.S. ____ (2010) While the Supreme Court admits that the machine-or-transformation test could be an important "clue," the Patent Office should look to the guideposts in *Gottschalk v. Benson*, 409 U.

S. 63, 67, 72 (1972), *Diamond v. Diehr*, 450 U. S. 175, 185 (1981), and *Parker v. Flook*, 437 U. S. 584, (1978). *Id.*

In *Diamond v. Diehr*, 450 U. S. 175, 185 (1981), the Supreme Court held that the execution of a physical process, controlled by a computer program, was patentable. Here, a physical process is performed; namely, the transformation of one word to another word by adding phonetic symbols to a training material. Again, a physical transformation is performed by the claims.

B. Rejection Of Claims 15-20 Under 35 U.S.C. § 102(b) As Being Unpatentable Over "Rocket Phonics"

35 U.S.C. §102(b) states that an inventor shall be entitled to a patent unless the invention was described in a printed publication more than one year prior to the date of the application for patent. The Office rejected claims 15-20 under 102(b) in view of "Rocket Phonics," relying on the publication date recited in the copyright registration. However, as the Applicant has repeatedly iterated, an incorrect publication date was given to the United States Copyright Office in the application for registration for "Rocket Phonics." The actual publication date of "Rocket Phonics" was on August 8, 2002. A corrected Supplementary Registration was filed with the United States Copyright Office on January 25, 2010 pursuant to 17 U.S.C. §408(d), and once the United States Copyright Office processes this registration, the Appellant will submit the new Supplementary Registration to this Board as evidence. Since "Rocket Phonics" was never actually published until August 8, 2002, "Rocket Phonics" does not qualify as prior art under 102(b).

CONCLUSION

Claims 15-20 are patentable for being drawn towards a physical process of altering training material. While the book "Rocket Phonics" may teach some of the subject matter recited in the claims, the book is ineligible for 102(b) purposes since this application was filed within a year of the publication date of "Rocket Phonics."

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1-14. (canceled)

15. A method of teaching phonetic reading, comprising:

presenting to a student an alphabet of phonetic symbols consisting of underlined and non-underlined letters selected from the group consisting of a, b, c, d, e, f, g, h, i, j, k,

l, m, n, o, p, q, r, s, t, u, v, w, x, y, z;

presenting a training material to the student, wherein the training material has a word with an ordinary spelling; and

revising at least part of the word to include at least one of the phonetic symbols.

16. The method of claim 15, wherein phonetic symbols consisting of single letters correspond to short vowel sounds.

17. The method of claim 15, wherein phonetic symbols consisting of more than one letter represent long vowel sounds.

18. The method of claim 15 further comprising displaying a line of words with ordinary spelling to the student and revising at least a part of the line of words to include at least one of the phonetic symbols.

19. The method of claim 15, further displaying a sentence of at least five words with ordinary spelling, and placing phonetic symbols of the alphabet below selected ones of the words as aids in pronunciation of the selected words.

20. The method of claim 19 further comprising displaying at least one of the words without a corresponding one of the phonetic symbols.

IX. EVIDENCE APPENDIX

The Appellant will submit into evidence the Supplementary Copyright Registration No. as soon as the United States Copyright Office processes the Appellant's corrected Supplementary Registration.

X. RELATED PROCEEDINGS APPENDIX

No related proceedings are known to the Appellant.